APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,107	04/11/2001	Hiroshi Miyanaga	P20117	8655

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EXAMINER
CHANG, SUNRAY

ART UNIT	PAPER NUMBER
2121	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Office Action Summary	09/832,107	MIYANAGA, HIROSHI
	Examiner	**Art Unit**	
	Sunray Chang	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 April 2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 April 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All   b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date *06022002*.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1.   Claims 1 – 15 are presented for examination.

Claims 1 – 15 are rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the

United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by

another filed in the United States before the invention by the applicant for patent, except that an international application

filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed

in the United States only if the international application designated the United States and was published under Article

21(2) of such treaty in the English language.

2.   **Claims 1, 5 – 8, 10 – 11, and 13 – 15 are rejected** under 35 U.S.C. 102(e) as being

anticipated by Kiyoshi Toyoda (U.S. Patent No. 6,094,277, and referred to as Toyoda_1998

hereinafter).

3.   **Regarding independent claim 1**, Toyoda_1998 teaches,

- An electronic mail communication apparatus. [Col. 2, Line 51 – 53]

- An electronic mail transmitter [transmission section, Col. 2, Line 55] that transmits image

  data to a destination via a mail server [Col. 2, Line 55 – 56];

- An image data memory [memory, Col. 2, Line 57] that stores [buffered, Col. 2, Line 57] the
  image data [email data, Col. 2, Line 56 – 57] to be transmitted [transmission section, Col. 2,
  Line 55];

- A memory that stores a capacity of the mail server [Col. 4, Line 11 – 13]; and

- A controller [output destination decision section, Fig. 1] that determines, before the
  electronic mail transmitter transmits the image data, whether an amount of the image data to
  be transmitted exceeds a capacity of the mail server, and that generates error information,
  when the amount of the image data exceeds the capacity of the mail server [Col. 5, Line 37 –
  44].

4.   **Regarding dependent claim 5,**

- Capacity memory stores a plurality of sets of data; each of the sets of data includes a
  destination [header, sender address, Col. 4, Line 40] and the capacity of the mail server
  [capacity, Col. 4, Line 10 – 13] through which the image data is passed when the image data
  is transmitted to the destination.

- Controller determines whether the amount of the image data exceeds the capacity of the mail
  server corresponding to the destination, by reference to the said capacity memory. [Col. 5,
  Line 40 – 44]

5.   **Regarding dependent claim 6,**

- A scanner that scans image data [2, Fig. 2 and Col. 3, Line 19 – 21]; and

- A facsimile transmitter [FAX, Fig. 1] that transmits [transfer, Col. 3, Line 10] the scanned image data [opened image information, Col. 3, Line 10] to a destination [destination, Col. 3, Line 9] via a public telephone line [PSTN, Fig. 1].

6. **Regarding independent claim 7,**

- An electronic mail communication apparatus. [Col. 2, Line 51 – 53]

- An electronic mail transmitter [transmission section, Col. 2, Line 55] that transmits image data to a destination via a transmission mail server [Col. 2, Line 55 – 56], and a reception mail server [Col. 2, Line 56 – 57];

- An image data memory [memory, Col. 2, Line 57] that stores [buffered, Col. 2, Line 57] the image data [email data, Col. 2, Line 56 – 57] to be transmitted [transmission section, Col. 2, Line 55];

- A capacity memory that stores a capacity of the transmission and reception mail servers [Col. 2, Line 55 – 57]; and

- The capacity stored being a smaller of the capacity [Col. 4, Line 10 – 13] of the transmission and reception mail server [Col. 2, Line 55 – 57];

- A controller [output destination decision section, Fig. 1] that determines, before the electronic mail transmitter transmits the image data, whether an amount of the image data to be transmitted exceeds a capacity of the mail server, and that generates error information, when the amount of the image data exceeds the capacity of the mail server [Col. 5, Line 37 – 44].

7.   **Regarding independent claim 8,**

- An electronic mail communication apparatus. [Col. 2, Line 51 – 53]

- An electronic mail transmitter [transmission section, Col. 2, Line 55] that transmits image data to a destination via a mail server [Col. 2, Line 55 – 56];

- An image data memory [memory, Col. 2, Line 57] that stores [buffered, Col. 2, Line 57] the image data [email data, Col. 2, Line 56 – 57] to be transmitted [transmission section, Col. 2, Line 55];

- A capacity memory that stores a capacity of the mail server [Col. 4, Line 11 – 13]; and

- A controller [output destination decision section, Fig. 1] that determines, before the electronic mail transmitter transmits the image data, whether an amount of the image data to be transmitted exceeds a capacity of the mail server [Col. 5, Line 37 – 40].

- Processing the image data to reduce the amount of the image data when the amount of the image data exceeds the capacity of the mail server [Col. 5, Line 64 – 65].

8.   **Regarding dependent claim 10,**

- The controller divides the image data to reduce the amount of the image data [Col. 5, Line 64 – 65].

9.   **Regarding independent Claim 11,**

- An electronic mail transmitter [transmission section, Col. 2, Line 55] that transmits image data to a destination via a mail server [Col. 2, Line 55 – 56];

- An image data memory [memory, Col. 2, Line 57] that stores [buffered, Col. 2, Line 57] the image data [email data, Col. 2, Line 56 – 57] to be transmitted [transmission section, Col. 2, Line 55];

- A memory that stores a capacity of the mail server [Col. 4, Line 11 – 13]; and

- A controller [output destination decision section, Fig. 1] that determines, before the electronic mail transmitter transmits the image data, whether an amount of the image data to be transmitted exceeds a capacity of the mail server.

- Each of the sets of data including an address of a mail server [header, sender address, Col. 4, Line 40] and a capacity of the mail server [capacity, Col. 4, Line 10 – 13].

- That refers to said mail server table to replace the predetermined address of the mail server with another address of a connectable mail server of the plurality of mail servers having a higher capacity so that the image data can be transmitted via the mail server having a capacity larger than the amount of the image data, when the amount of the image data exceeds the capacity of the mail server having the predetermined address [Col. 3, Line 6 – 13].

10.   **Regarding independent claim 13,**

- Accepting image data [2, Fig. 1];

- Determines, before the electronic mail transmitter transmits the image data, whether an amount of the image data to be transmitted exceeds a capacity of the mail server, and that generates error information, when the amount of the image data exceeds the capacity of the mail server [Col. 5, Line 37 – 44].

- Transmitting the image data when the amount of the image data to be transmitted is not

  larger than the capacity of the mail server [Col. 5, Line 37 – 44].

11.   **Regarding independent claim 14,**

- Accepting image data [2, Fig. 1];

- Determines, before the electronic mail transmitter transmits the image data, whether an

  amount of the image data to be transmitted exceeds a capacity of the mail server [Col. 5, Line

  37 – 44].

- Processing the image data to reduce the amount of the image data when the amount of the

  image data to be transmitted exceeds the capacity of the mail server [Col. 5, Line 64 – 65];

- Transmitting the image data when the transmission data amount of the image data is not

  larger than the capacity of the mail server [Col. 5, Line 37 – 44].

12.   **Regarding independent claim 15,**

- Accepting image data [2, Fig. 1];

- Determines, before the electronic mail transmitter transmits the image data, whether an

  amount of the image data to be transmitted exceeds a capacity of the mail server [Col. 5, Line

  37 – 44].

- Changing from the predetermined mail server to an other connectable mail server having a

  server capacity higher than the amount of the image data to be transmitted, when the amount

  of the image data to be transmitted exceeds the capacity of the predetermined mail server

  [Col. 3, Line 6 – 13];

- Transmitting the image data when the amount of the image data to be transmitted is not

  larger than the limit capacity of the predetermined mail server [Col. 5, Line 37 – 44]; and

- Transmitting the image data through the connectable mail server having a server capacity

  higher than the amount of image data to be transmitted, when the amount of image data to be

  transmitted exceeds the capacity of the predetermined mail server [Col. 3, Line 6 – 13].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness
   or nonobviousness.

13. **Claims 2 – 4, 9, and 11 – 12 are rejected** under 35 U.S.C. 103(a) as being unpatentable

over Toyoda_1998, and in view of Kiyoshi Toyoda (U.S. Patent No. 6,778,287, and referred to

as Toyoda_1999 hereinafter).

(Toyoda_1998 as set forth above generally discloses the basic inventions.)

14.   **Regarding dependent Claim 2**, Toyoda_1998 teaches error indication [error type data]

when the amount of the image data is larger than the capacity of the mail server [Col. 5, Line 37

– 44].

Toyoda_1998 does not teach a speaker.

Toyoda_1999 teaches a speaker [Col. 13, Line 55] for the purpose of generating a sound.

It would have been obvious to a person of ordinary skill in the art at the time of

applicant's invention to modify the teaching of Toyoda_1998 to include "a speaker"with the

motivation being to provide for the purpose of generating a sound.

15.   **Regarding dependent Claim 3**, Toyoda_1998 teaches deciding whether the image data

will be transmitted or the image data transmission will be prevented when the amount of the

image data exceeds the capacity of the mail server [Col. 5, Line 37 – 44].

Toyoda_1998 does not teach a display that displays a selectable option.

Toyoda_1999 teaches a display [Col. 16, Line 25] that displays a selectable option

[destination list, Col. 16, Line 33 – 34] for the purpose of enabling a destination list to be

indicated.

It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teaching of Toyoda_1998 to include "a display that displays a selectable option" for the purpose of enabling a destination list to be indicated.

16.   **Regarding dependent Claim 4**, Toyoda_1998 teaches when it is decided that the image data will be transmitted, the electronic mail transmitter transmits the image data within the capacity, and the controller sets a stop flag to indicate that a remainder of the image data will be transmitted later [Col. 5, Line 37 – 44].

17.   **Regarding dependent Claim 9,**

Toyoda_1998 teaches controller processes the image data to reduce the amount of the image data [Col. 5, Line 64 – 65].

Toyoda_1998 does not teach converting a resolution of the image data.

Toyoda_1999 teaches converting a resolution [format converter, Fig. 1] of the image data for the purpose of transferring binary image data.

It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teaching of Toyoda_1998 to include "converting a resolution of the image data" for the purpose of transferring binary image data.

18.   **Regarding independent Claim 12,**

Toyoda_1998 teaches

- An electronic mail communication apparatus. [Col. 2, Line 51 – 53]

- A scanner that scans image data [2, Fig. 2 and Col. 3, Line 19 – 21]; and

- An electronic mail transmitter [transmission section, Col. 2, Line 55] that transmits image data to a destination via a mail server [Col. 2, Line 55 – 56];

- An image data memory [memory, Col. 2, Line 57] that stores [buffered, Col. 2, Line 57] the image data [email data, Col. 2, Line 56 – 57] to be transmitted [transmission section, Col. 2, Line 55];

- A memory that stores a capacity of the mail server [Col. 4, Line 11 – 13]; and

- A controller [output destination decision section, Fig. 1] that determines, before the electronic mail transmitter transmits the image data, whether an amount of the image data to be transmitted exceeds a capacity of the mail server, and that generates error information, when the amount of the image data exceeds the capacity of the mail server [Col. 5, Line 37 – 44].

- Controller transmits data via the mail server when the amount of the image data is not larger than the limit capacity of the mail server [Col. 5, Line 64 – 65].

Toyoda_1998 does not teach converts the image data into a format for transmission.

Toyoda_1999 teaches converts the image data into a format [format converter, Fig. 1] for transmission.

It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teaching of Toyoda_1998 to include "converts the image data into a format for transmission" for the purpose of transmission.

Conclusion

19.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. Yoshiura (U.S. Patent No. 6,785,017) discloses an email server, an attached file, an

error message, converting, a FAX, a display device, and a facsimile processing. Kennedy (U.S.

Patent No. 6,134,582) discloses a mail message, a database, a size restriction, a SMTP, a MIME.

20.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Sunray Chang whose telephone number is 703-305-8744 or after

October 12, 2004 at (571) 272-3682. The examiner can normally be reached on M-F 7:00-4:30.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Anthony Knight can be reached on (703)308-3179 or after October 12, 2004 at (571)

272-3687. The fax phone number for the organization where this application or proceeding is

assigned is 703-872-9306.

        Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-746-3506.

Sunray Chang
Patent Examiner
Group Art Unit 2121   Anthony Knight
Technology Center 2100   Supervisory Patent Examiner
U.S. Patent and Trademark Office   Group 3600

October 1, 2004